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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,846	03/12/2001	Tetsushi Nomoto	108611	7817
25944	7590	07/28/2005	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			SINGH, SATWANT K	
			ART UNIT	PAPER NUMBER
			2626	

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/802,846	Applicant(s) NOMOTO, TETSUSHI	
	Examiner Satwant K. Singh	Art Unit 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-36 and 44-47 is/are allowed.
- 6) ☒ Claim(s) 37-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is in response to the amendment filed on 26 January 2005.

### ***Response to Arguments***

2. Applicant's arguments, see amendment, filed 26 January 2005, with respect to the rejection(s) of claim(s) 37-43 under Garfinkle et al. (US 6,017,157) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Chui et al. (US 6,657,702).

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 37-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Chui et al. (US 6,657,702).
5. Regarding Claim 37, Chui et al disclose a method of providing a print of an image registered by a registrant in relation to a product of digital contents to be sold by the

registrant and purchased by a purchaser comprising: a first step of selling the product of digital contents to a purchaser (Fig. 4, S404) (use can place an order with the photo-finisher) (col. 14, lines 47-65); and a second step of outputting information relating to the image in relation to the product of digital contents sold to the purchaser through a computer communication for the purpose of producing the print of the image (Fig. 7A-7C) (menu options for distributing image prints) (col. 18, lines 48-58).

6. Regarding Claim 38, Chui et al disclose a method, wherein the first step includes a step of copying the digital contents on a recording medium of the purchaser (photo-finisher loads data or programs for the user's benefit onto the storage medium before returning it to the user) (col. 12, lines 59-67, col. 13, lines 1-11).

7. Regarding Claim 39, Chui et al disclose a method, further comprising a step of making the purchaser select one of a plurality of images relating to the digital contents (designating which of the images should be printed) (col. 14, lines 1-8).

8. Regarding Claim 40, Chui et al disclose a method, wherein the information includes an image data of the digital image (Fig. 7B, menu level 730) (attributes of the physical image copies) (col. 19, lines 49-64).

9. Regarding Claim 41, Chui et al disclose a method, wherein the information includes information that specifies the image (Fig. 7B, menu level 730) (attributes of the physical image copies) (col. 19, lines 49-64).

10. Regarding Claim 42, Chui et al disclose a method, further comprising a step of obtaining information necessary for delivering the print to the purchaser (Fig. 6, contact information 606) (lines 18, col. 25-47); and a step of outputting information for delivery

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through a computer communication (Fig. 7A, menu levels 712, 718, 721) (col. 19, lines 18-25).

11. Regarding Claim 43, Chui et al disclose an apparatus for providing a print of an image registered by a registrant in relation to a product of digital contents to be sold by the registrant and purchased by a purchaser comprising: a contents seller that sells the product of digital contents to a purchaser (Fig. 4, S404) (use can place an order with the photo-finisher) (col. 14, lines 47-65); a delivery information for inputting an information for delivery of the print of the image for the purchaser (Fig. 6, contact information 606) (lines 18, col. 25-47); and an information output that outputs (i) an information of the image relating to the product of the digital that was sold to the purchaser (Fig. 7B, menu level 730) (attributes of the physical image copies) (col. 19, lines 49-64) and (ii) the information for delivery of the print (Fig. 7A, menu levels 712, 718, 721) (col. 19, lines 18-25).

#### ***Allowable Subject Matter***

12. Claims 1-37 and 44-47 are allowed.

13. The following is a statement of reasons for the indication of allowable subject matter. Claims 1, 17, 22, 23, 32, 36, and 44, of the current application teaches similar subject matter as the prior art of Garfinkle et al. (US 6,017,157), Redd et al. (US 6,646,754) and Chui et al. (US 6,657,702). However claims 1, 17, 22, 23, 32, 36, and 44 are allowed for the reasons pointed out by Applicant's remarks (page 11, 1<sup>st</sup> – 3<sup>rd</sup> paragraphs, page 12, 2<sup>nd</sup> – 3<sup>rd</sup> paragraphs, and page 13, 4<sup>th</sup> paragraph).

14. Claims 2-16, 18-21, 24-31, 33-35, and 45-47 are allowable for being dependent on an allowable base claim.

### ***Conclusion***

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satwant K. Singh whose telephone number is (571) 272-7468. The examiner can normally be reached on Monday thru Friday 8am - 4:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Satwant Singh*

Satwant K. Singh  
Examiner  
Art Unit 2626

sks

*KAWilliams*  
KIMBERLY WILLIAMS  
SUPERVISORY PATENT EXAMINER